

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

The Examiner acknowledged and fully considered Applicants' amendment and response filed on November 15, 2005 in the present application.

Claims 64, 65 and 94-127 are pending in the present application.

Of the above claims, claims 64, 65, 102, 105-109 and 111-127 have been withdrawn from consideration as being drawn to nonelected inventions. Claims 94-101, 103-104 and 110 are currently being examined in the present application and have been finally rejected.

According to the Examiner, a complete reply to this final rejection must include cancellation of the non-elected claims (64, 65, 102, 105-109 and 111-127) or other appropriate action (37 CFR 1.144). In the present amendment and reply, Applicants have canceled claims 64, 65, 102, 105-109 and 111-127, without prejudice to pursuing these claims in one or more other applications.

The cross-reference in the specification has been updated, since Application No. 09/453,840 has now issued as U.S. Patent No. 6,716,816.

Claim 94 has been amended to correct inadvertent typographical errors in the definition of the variables R and R': (C₁-C₆) alkenyl has been corrected to (C₂-C₆) alkenyl; likewise, (C₁-C₆) alkynyl has been corrected to (C₂-C₆) alkynyl. No new matter has been introduced with these amendments, and their entry is respectfully requested.

Applicants would bring to the Examiner's attention the New Power of Attorney form that is included herewith as well as the additional Attorney Docket No. (PC20700J) that has been assigned to this application.

I. WITHDRAWN CLAIM REJECTIONS

The Examiner noted that the rejections of claims 63, 66-93 on several grounds have been withdrawn in view of Applicants' cancellation of these claims in Applicants' previous amendment and response. The Examiner also noted that the rejection of claims 94-101, 103-104 and 110 over U.S. Patents 6,753,313; 6,716,816; 6,602,854; 6,004,925; and 6,376,464 set forth

in the previous office action has been withdrawn in view of the filing and entering of the terminal disclaimers. The withdrawal of these rejections is also noted separately below.

II. MAINTAINED CLAIM REJECTIONS

The Examiner noted that the obviousness-type double patenting rejection of claims 94-101, 103-104 and 110 over U.S. Patents 6,630,450; 6,518,412; and 6,329,341 has been maintained for the reasons of record. The Examiner also noted that the provisional obviousness-type double patenting rejection of claims 94-101, 103-104 and 110 over claims 1-68 of co-pending Application No. 10/283,599; and claims 1-56 of co-pending Application No. 10/099,836 has been maintained for the reasons of record. These rejections are addressed below.

III. NONSTATUTORY DOUBLE PATENTING REJECTIONS

A. U.S. Patent Application Serial Nos. 10/283,599 and 10/099,836

Claims 63, 66-101, 103, 104 and 110 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-68 of co-pending Application No. 10/283,599; and claims 1-56 of co-pending Application No. 10/099,836. According to the Examiner, although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the above-cited applications teach pharmaceutical compositions comprising Apo-AI agonist peptide compounds comprising 15-29 residues. The Examiner noted that this is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. The Examiner also noted that Applicants' arguments filed on November 15, 2005 have been fully considered but they are not persuasive, and the rejection has been maintained. Separate response is given below regarding these applications cited by the Examiner:

1. U.S. Patent No. 6,844,327 (U.S. Application Serial No. 10/283,599)

Applicants would note that the application Serial No. 10/283,599 has issued as a U.S. Patent No. 6,844,327 on January 18, 2005 (hereinafter, the '327 patent). Applicants respectfully submit that this rejection is moot with respect to claims 63 and 66-93 in view of cancellation of these claims. With respect to claims 94-101, 103, 104 and 110, without acquiescing with the

propriety of the rejection and in order to expedite prosecution, Applicants respectfully request that the rejection be withdrawn in view of the Terminal Disclaimer and fee filed herewith.

2. U.S. Application Serial No. 10/099,836

Applicants respectfully submit that this rejection is moot with respect to claims 63 and 66-93 in view of cancellation of these claims. With respect to claims 94-101, 103, 104 and 110, without acquiescing with the propriety of the rejection and in order to expedite prosecution, Applicants respectfully request that the rejection be withdrawn in view of the Terminal Disclaimer and fee filed herewith.

B. U.S. Patent Nos. 6,753,313; 6,716,816; 6,630,450; 6,602,854; 6,518,412; 6,376,464; 6,329,341; and 6,004,925

Claims 63, 66-101, 103-104 and 110 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

- i) claims 1-48 of U.S. Patent No. 6,753,313;
- ii) claims 1-58 of U.S. Patent No. 6,716,816;
- iii) claims 1-36 of U.S. Patent No. 6,630,450;
- iv) claims 1-38 of U.S. Patent No. 6,602,854;
- v) claims 1-9 of U.S. Patent No. 6,518,412;
- vi) claims 1-21 of U.S. Patent No. 6,376,464;
- vii) claims 1-21 of U.S. Patent No. 6,329,341; and
- viii) claims 1-58 of U.S. Patent No. 6,004,925.

According to the Examiner, although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the above-cited patents teach pharmaceutical compositions comprising Apo-AI agonist peptide compounds comprising 15-29 residues. The Examiner noted that Applicants' arguments filed on November 15, 2005 regarding the ODP rejections of claims over U.S. Patents 6,630,450; 6,329,341; and 6,518,412 have been fully considered but they are not persuasive, and the rejection has been maintained. Separate response is given below regarding each patent cited by the Examiner:

1. U.S. Patent No. 6,753,313

Applicants respectfully submit that the rejection is moot with respect to claims 63 and 66-93 in view of cancellation of these claims. With respect to claims 94-101, 103, 104 and 110, Applicants would note that this rejection has been withdrawn in view of the filing and entering of terminal disclaimer for this patent with Applicants' previous Amendment and Response under 37 CFR. §1.111, dated November 15, 2005.

2. U.S. Patent No. 6,716,816

Applicants respectfully submit that the rejection is moot with respect to claims 63 and 66-93 in view of cancellation of these claims. With respect to claims 94-101, 103, 104 and 110, Applicants would note that this rejection has been withdrawn in view of the filing and entering of terminal disclaimer for this patent with Applicants' previous Amendment and Response under 37 CFR. §1.111, dated November 15, 2005.

3. U.S. Patent No. 6,630,450

Applicants respectfully submit that the rejection is moot with respect to claims 63 and 66-93 in view of cancellation of these claims. With respect to claims 94-101, 103, 104 and 110, without acquiescing with the propriety of the rejection and in order to expedite prosecution, Applicants respectfully request that the rejection be withdrawn in view of the Terminal Disclaimer and fee filed herewith.

4. U.S. Patent No. 6,602,854

Applicants respectfully submit that the rejection is moot with respect to claims 63 and 66-93 in view of cancellation of these claims. With respect to claims 94-101, 103, 104 and 110, Applicants would note that this rejection has been withdrawn in view of the filing and entering of terminal disclaimer for this patent with Applicants' previous Amendment and Response under 37 CFR. §1.111, dated November 15, 2005.

5. U.S. Patent No. 6,518,412

Applicants respectfully submit that the rejection is moot with respect to claims 63 and 66-93 in view of cancellation of these claims. With respect to claims 94-101, 103, 104 and 110, without acquiescing with the propriety of the rejection and in order to expedite prosecution,

Applicants respectfully request that the rejection be withdrawn in view of the Terminal Disclaimer and fee filed herewith.

6. U.S. Patent No. 6,376,464

Applicants respectfully submit that the rejection is moot with respect to claims 63 and 66-93 in view of cancellation of these claims. With respect to claims 94-101, 103, 104 and 110. Applicants would note that this rejection has been withdrawn in view of the filing and entering of terminal disclaimer for this patent with Applicants' previous Amendment and Response under 37 CFR. §1.111, dated November 15, 2005.

7. U.S. Patent No. 6,329,341

Applicants respectfully submit that the rejection is moot with respect to claims 63 and 66-93 in view of cancellation of these claims. With respect to claims 94-101, 103, 104 and 110, without acquiescing with the propriety of the rejection and in order to expedite prosecution, Applicants respectfully request that the rejection be withdrawn in view of the Terminal Disclaimer and fee filed herewith.

8. U.S. Patent No. 6,004,925

Applicants respectfully submit that the rejection is moot with respect to claims 63 and 66-93 in view of cancellation of these claims. With respect to claims 94-101, 103, 104 and 110, Applicants would note that this rejection has been withdrawn in view of the filing and entering of terminal disclaimer for this patent with Applicants' previous Amendment and Response under 37 CFR. §1.111, dated November 15, 2005.

CONCLUSIONS

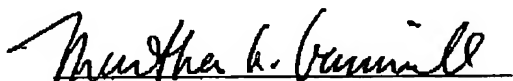
In light of the above amendments and remarks, Applicants respectfully submit that claims 94-101, 103, 104 and 110 have been put in condition for allowance. Notification to this effect is earnestly solicited. The Examiner is encouraged to contact the Applicants' undersigned attorney to discuss this matter if any questions should arise upon further examination of the pending claims.

The Commissioner is hereby authorized to charge any required fee(s), including extension of time fees under 37 CFR §1.17, or credit any overpayment, to 23-0455 (referencing Attorney Docket No. 9191-031-999 (PC20700J)).

Respectfully submitted,

Date:

8/18/06


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